

REMARKS

The fourth Official Action rejects all of the pending claims, namely Claims 33-56, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,787,403 to Randle in view of U.S. Patent No. 5,819,285 to Damico et al., as before, and now further in view of U.S. Patent No. 6,141,666 to Tobin. As explained below, Applicants respectfully submit that the claimed invention is patentably distinct from the Randle, Damico and Tobin patents, taken either individually or in combination. Accordingly, Applicants respectfully traverse the rejections raised in the Official Action and respectfully request reconsideration and allowance of all of the pending claims of the present application.

As indicated above, the Official Action rejects Claims 33-56 as being unpatentable over the Randle patent in view of the Damico patent, and further in view of the Tobin patent. More particularly, the Official Action alleges that the Randle patent discloses a method for managing information using an intermediary gateway device having a corresponding network address, where the method includes receiving a request to communicate with a datastore having a network address, and providing access to the datastore through the intermediary gateway device. The Official Action alleges that the Damico patent discloses modifying the network address of the datastore, as recited by the claimed invention. The Official Action then alleges that one skilled in the art would be motivated to modify the system of the Randle patent to include the address modification feature of the Damico patent to track user paths on the Web to determine the identity of the entity that directed the user to the current Web site for transactional purposes.

While the Official Action concedes that neither the Randle patent nor the Damico patent, either individually or in combination, teaches or suggests modifying the network address of the datastore to incorporate the address of the intermediary gateway device, the Official Action alleges that the Tobin patent discloses this feature. The Official Action further alleges that one skilled in the art would be motivated to modify the combined system of the Randle and Damico patents to include the address incorporation feature of the Tobin patent to track and compensate a site owner for orders placed by customers through the modified link.

Independent Claims 33, 35, 37, 39, 41-45, 47, 49, 51 and 53-56 of the present application provide methods, computers, computer-readable mediums and apparatuses for managing

information. As recited, a request to communicate with a network-accessible datastore is received. Then, access is provided to the network-accessible datastore through an intermediary gateway device using a network address (URL) incorporating the address (URL) of the network-accessible datastore and an address (URL) of an intermediary gateway device. In this regard, the address (URL) of the network-accessible datastore is modified to incorporate the address (URL) of the intermediary gateway device.

In contrast to the claimed invention of independent Claims 33, 35, 37, 39, 41-45, 47, 49, 51 and 53-56 (as well as new Claims 57-60), the Randle patent does not teach or suggest providing access to a network-accessible datastore through an intermediary gateway device having a network address. The Randle patent discloses a bank-centric service platform that provides an access gateway from a bank at a central location to non-bank information, products and services of providers not otherwise related to the bank. The Randle patent does not disclose that the access gateway has a network address, as does the intermediary gateway device of the claimed invention.

In contrast to the Official Action, Applicants also respectfully submit that even if the Damico patent discloses the address-modification feature, the motivation suggested by the Official Action for combining the Randle and Damico patents is lacking. In this regard, the Randle patent does not disclose a network comprising the Web, the Internet or any other Wide Area Network (WAN). Accordingly, the Randle patent does not disclose a network address to be modified. Thus, there is no reason for combining the references.

In addition to the problems with the Randle/Damico combination, Applicants further submit that the Tobin patent is not prior art under any section of 102. The Tobin patent has a filing date of January 21, 1997 and claims priority from two provisional applications, one filed January 22, 1996 (the "first Tobin provisional application") and the other filed May 22, 1996 (the "second Tobin provisional application"). The present application, on the other hand, has a filing date of January 13, 2000 and is a continuation of a divisional of a parent application filed July 24, 1996, and ultimately claims priority from a provisional patent application filed April 1, 1996. The present application therefore has an effective filing date (from either the July 24, 1996 parent application, or the April 1, 1996 provisional application) before the filing date of the

Tobin patent on January 21, 1997. Accordingly, the Tobin patent is only prior art for the subject matter that was first disclosed by the Tobin provisional applications. By way of example, the content of the Tobin provisional applications that is carried over into the Tobin patent may be considered prior art, excluding subject matter first disclosed by the Tobin provisional application of May 22, 1996, which is not prior art to subject matter of the present application. Subject matter that is newly added in the Tobin patent that was not disclosed by the Tobin provisional applications is not prior art relative to the present application.

In order to determine the relevance of the Tobin patent to the claimed invention, Applicants' undersigned attorney has obtained and reviewed copies of the Tobin provisional applications, and encloses copies herewith. The Official Action cited portions of the Tobin patent directed to dynamic tokening as corresponding to the address incorporation feature of the claimed invention. While the first Tobin provisional application includes a brief overview of dynamic tokening, the second Tobin provisional application is silent as to this technique. Accordingly, the following discussion is focused on the first Tobin provisional application in relation to the claimed invention.

As disclosed by the first Tobin provisional application, the system includes a number of Internet participants that are each assigned tokens that correspond to the respective participant's Web site, or more particularly, a site URL assigned to the respective participant. Each Internet participant also designs the participant's Web site to incorporate a graphical reminder related to a floral/gift service, where the reminder includes a hypertext link to a PC Flowers & Gifts Web site, or more particularly to a home page of the PC Flowers & Gifts Web site. Accordingly, a user can select the graphical reminder from the participant's Web site to jump to the home page of the PC Flowers & Gifts Web site, where the token of the respective participant is "dynamically inserted into the home page for tracking of its use." First Tobin Provisional Application, page 10. As the user navigates through the various pages of the PC Flowers & Gifts Web site, the token of the respective participant is passed to each of the respective pages. Then, when the user places an order from one of the PC Flowers & Gifts Web site pages, the token of the respective participant is recorded such that the respective participant can receive a commission based on the order.

The first Tobin provisional application therefore discloses a dynamic tokening technique whereby a token assigned to a participant who has a Web site from which a user accesses a PC Flowers & Gifts Web site. The token of the respective participant is then inserted into the home page of a PC Flowers & Gifts Web site, and various other pages of the PC Flowers & Gifts Web site as the user navigates to those pages. In contrast to the claimed invention, however, the first Tobin provisional application (or second Tobin provisional application), does not teach or suggest modifying the network address of the datastore to incorporate the address of the intermediary gateway device. In this regard, the first Tobin provisional application discloses that tokens are “inserted” into the home page and other pages of the PC Flowers & Gifts Web site, but provide no disclosure as to how the tokens are so inserted much less that a URL is modified to incorporate a token, in a manner similar to that recited in the claims.

Further, even if the first Tobin provisional application could be interpreted as inserting a token by incorporating it in a URL, Applicants respectfully submit that the first Tobin provisional application still does not teach or suggest that the token is a network address, much less the network address of a intermediary gateway device, recited by the claimed invention. The first Tobin provisional application does disclose that the token corresponds to a Web site, and identifies a site URL. The first Tobin provisional application does not disclose, however, that the token is the site URL. If such were the case, Applicants wonder why the patentee chose to describe the token as “identifying” a site URL, instead of comprising the site URL. Applicants respectfully submit that the patentee did not describe the token as comprising the site URL because the patentee, in fact, intended the token to comprise a value associated with the site URL, as opposed to the site URL.

As evidence of the fact that the tokens described in the first Tobin provisional application do not comprise site URLs, Applicants direct the Examiner to column 11 of the Tobin patent. As disclosed, a link calling a tokening executable appears as “tokening?site_token&file_name.” As an example, the Tobin patent includes the following: “tokening.cgi?80&/occasion.htm.” Drawing a correlation between the link format and the disclosed example, then, the token (i.e., site_token) comprises a value (e.g., 80), and not a URL or network address similar to that of the intermediary gateway device of the claimed invention. As another example, the Tobin patent

provides the link format "track.cgi?site_token&file_name," and provides the example "track.cgi?90&/homehtm." Even in this example, the token comprises a value, as opposed to a URL or network address.

Thus, Applicants respectfully submit that none of the Randle patent, the Damico patent or Tobin provisional applications (the disclosure of which serves as the only potential basis by which portions of the Tobin patent may be considered prior art), taken individually or in combination, teach or suggest the claimed invention of independent Claims 33, 35, 37, 39, 41-45, 47, 49, 51, 53-60. Also, as dependent Claims 34, 36, 38, 40, 46, 48, 50 and 52, depend directly or indirectly from independent Claims 33, 35, 37, 39, 41-45, 47, 49, 51, 53-56, Applicants further respectfully submit that none of the Randle patent, the Damico patent or Tobin provisional applications, taken individually or in combination, teach or suggest the claimed invention of dependent Claims 34, 36, 38, 40, 46, 48, 50 and 52. Applicants therefore respectfully submit that the rejection of Claims 33-56 under 35 U.S.C. § 103(a) is overcome.

Appl. No.: 09/482,032
Amdt. dated 04/11/2005
Reply to Official Action of January 11, 2005

CONCLUSION

In view of the remarks presented above, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

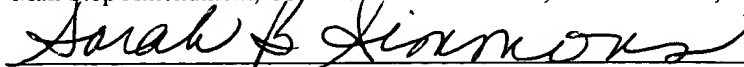


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